

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed on April 1, 2009. This Reply encompasses a bona fide attempt to overcome the rejections raised by the Examiner. Applicant believes that the claimed invention is novel and unobvious over the applied prior art. Accordingly, Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 1-8, 10-13, 15, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,245,108 ("Biscup") alone or, in the alternative, in view of U.S. Patent No. 6,468,311 ("Boyd"). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Biscup alone or, in the alternative, in view of Boyd and further in view of U.S. Patent Application Publication No. 2005/0004671 ("Ross"). The rejections are respectfully traversed. Since the Office Action mailed on April 1, 2009 is essentially the same as the Office Action mailed on December 9, 2008, arguments submitted in the previous Reply filed on February 26, 2009 remain pertinent and are fully incorporated herein by reference.

In the Office Action mailed on April 1, 2009, the Examiner stated on page 6 that Applicant's arguments, filed February 26, 2009, with respect to the amended claims were not persuasive because "what may be considered the 'top' and the 'bottom' is open to varying interpretation." The Examiner then showed FIG. 2 of Biscup with an arrow pointing to the top wall 20. The Examiner further stated that "the 'bottom' could be considered to begin at a respective portion." The Examiner did not point out what that respective portion might be with respect to FIG. 2 of Biscup on page 6 of the Office Action mailed on April 1, 2009. However, Biscup explicitly shows and describes the bottom wall 30. FIG. 2 of Biscup does not show any groove extending from the top wall 20 to the bottom wall 30 of the implant. FIG. 2 of Biscup does not show opposite grooves on the anterior and posterior sides of the implant. FIG. 2 of Biscup does not show the anterior and posterior sides of the implant having curves that are substantially in the same direction. FIG. 2 of Biscup does not show grooves located substantially equidistant from the proximal end of the implant on opposite sides.

According to M.P.E.P. 2111, the Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Furthermore, reasonable claim interpretation must be consistent with what a person of ordinary skill in the art would have reached in view of the disclosure. Given Biscup's explicit disclosure of the top wall 20 and the bottom wall 30, a person of ordinary skill in the art would not have considered FIG. 2 of Biscup as "open to varying interpretation."

Likewise, broadest reasonable interpretation of the claim terms "top" and "bottom" must be consistent with what a person of ordinary skill in the art would have reached in view of the disclosure. For example, claim 1 recites:

A spinal implant, comprising:
a top, wherein at least a portion of the top is shaped to contact a first vertebra;
a bottom, wherein at least a portion of the bottom is shaped to contact a second vertebra;
an anterior side having:
 a first curvature between a distal end and a proximal end; and
 a first groove near said proximal end and extending from said top to said bottom;
a posterior side having:
 a second curvature between said distal end and said proximal end; and
 a second groove near said proximal end and extending from said top to said bottom,
wherein said first groove and said second groove are located substantially equidistant from said proximal end, wherein the first curvature and the second curvature are substantially in the same direction; and
an opening extending through the spinal implant from the top to the bottom.

Thus, a person of ordinary skill in the art would have considered that an embodiment of a spinal implant would have a top, a bottom, an anterior side, a posterior side, and an opening as particularly recited in claim 1. Specifically, a person of ordinary skill in the art would have interpreted that, as recited in claim 1, at least a portion of the top is shaped to contact a first

vertebra, at least a portion of the bottom is shaped to contact a second vertebra, the anterior side is between the top and the bottom and has a groove extending from the top to the bottom near a proximal end of the implant, and the posterior side is also between the top and the bottom and has another groove extending from the top to the bottom near the proximal end of the implant, opposite the anterior side. The grooves, on opposite sides of the implant, are located substantially equidistant from the proximal end. These opposite (anterior and posterior) sides of the implant have curves that are substantially in the same direction. Biscup simply does not meet these claim limitations.

Again, as submitted before, Biscup is for bilateral placement in the spine and that a modification of Biscup's spinal fusion implant would change the principle of operation of the device, negating any motivation by one of ordinary skill in the art to modify Biscup or modify Biscup with Boyd in a manner as alleged by the Examiner. At least because one skilled in the art at the time of the invention could not have combined the elements as claimed by known methods with no change in their respective functions, Applicant believes that embodiments as claimed in claims 1-8, 10-13, 15-17, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97 remain patentable under 35 U.S.C. § 103(a) over Biscup, Boyd, and Ross, individually and in combinations.

As a good faith to expedite the prosecution of the present application, independent claims 1, 36, and 49 are amended herein. No new matter is introduced. Accordingly, withdrawal of this rejection is requested.

Conclusion

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include any acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of claims 1-8, 10-13, 15-17, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

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